REMARKS

The following remarks are made in response to the non-Final Office Action mailed December 22, 2006. Claims 14-18 were rejected. Claims 1, 3-13 and 19-24 were allowed. With this Response, claim 17 has been amended. Claims 1 and 3-24 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. §101

Claims 14-18 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

The Office Action has failed to set forth a *prima facie* case that claims 14-18 are directed to non-statutory subject matter. The Office Action does not assert that claims 14-18 are not within one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. §101 (i.e., a process, a machine, a manufacture or a composition of material). See MPEP § 2106 (IV)(B). In addition, the Office Action does not assert that claims 14-18 fall within one of the judicial exceptions to 35 U.S.C. §101 (i.e., abstract ideas such as mathematical algorithms, natural phenomena, or laws of nature). See MPEP § 2106 (IV)(C).

"The examiner bears the initial burden ... of presenting a prima facie case of unpatentability." In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444, (Fed. Cir. 1992) (cited in MPEP § 2106 (IV)(D)). To establish a *prima facie* case that claims 14-18 are directed to non-statutory subject matter based on a judicial exception to 35 U.S.C. §101, the Office Action must identify and explain in the record the reasons why a claim is for an abstract idea with no practical application. See MPEP § 2106 (IV)(D). The present Office Action only alleges that claim 14 "recite[s] a group of actions performed by a computer, but these actions produce no tangible result". The Office Action neither identifies an abstract idea embodied by claims 14-18 nor asserts that claims 14-18 have no practical application.

Even assuming *arguendo* that the Office Action can identify an abstract idea embodied by claims 14-18, the Office Action must show that claims 14-18 do not provide a transformation or reduction of an article to a different state or thing and do not produce a useful, tangible, and concrete result to demonstrate that claims 14-18 have no practical application. See MPEP §§ 2106 (IV)(C)(1) and 2106 (IV)(C)(2).

Even assuming *arguendo* that the Office Action is correct in that no tangible result is produced by claims 14-18, Applicants respectfully note that claim 14 recites "de-allocating the first cell from the operating system; allocating a second cell to the operating system subsequent to de-allocating the first cell from the operating system; and testing the first cell with a test module that is external to the first cell." Applicants respectfully submit that these features of claim 14 clearly transform "the first cell" and "the second cell" into different states and therefore claim 14 has a practical application. Accordingly, claim 14 and claims 15-18 which depend from claim 14 have a practical application and do not fall within a judicial exception to 35 U.S.C. §101 for at least this reason.

In addition, Applicants respectfully submit that these features of claim 14 do in fact produce useful, tangible, and concrete results. Namely, "de-allocating the first cell" and "testing the first cell" produces a useful, tangible, and concrete result associated with the first cell and "allocating a second cell" produces a useful, tangible, and concrete result associated with the second cell as recited in claim 14. Therefore, claim 14 and claims 15-18 which depend from claim 14 have a practical application and do not fall within a judicial exception to 35 U.S.C. §101 for at least this additional reason.

Further, claim 17 has been amended to recite "storing results of testing the first cell." Applicants respectfully submit that this feature of claim 17 produces a useful, tangible, and concrete result. Accordingly, claim 17 has a practical application and does not fall within a judicial exception to 35 U.S.C. §101 for at least this reason.

As described above, the Office Action has failed to set forth a *prima facie* case that claims 14-18 are directed to non-statutory subject matter. Accordingly, Applicants respectfully request withdrawal of rejection of claims 14-18 under 35 U.S.C. §101.

In the event that the Examiner attempts to set forth a *prima facie* case that claims 14-18 are directed to non-statutory subject matter in a subsequent Office Action, the Examiner is respectfully requested to issue a non-final Office Action to allow Applicants an opportunity to address

Allowable Subject Matter

Claims 1, 3-13 and 19-24 were allowed.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1 and 3-24 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1 and 3-24 is respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either David A. Plettner at Telephone No. (408) 447-3013, Facsimile No. (408) 447-0854 or Christopher P. Kosh at Telephone No. (512) 231-0533, Facsimile No. (512) 231-0540. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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